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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,306	03/21/2001	Mikio Fujita		4831

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/01/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/814,306

Applicant(s)

FUJITA, MIKIO

Examiner

Donald L. Champagne

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Support of Registered Attorney or Agent*

1. While an inventor may prosecute the application, it is the USPTO's experience that lack of prosecution experience usually acts as a liability in affording the maximum protection for the invention disclosed. The Office recommends that applicant consider securing the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution.
2. The following sources are available for selecting an Attorney or agent.
  - (A) Applicant can search the roster of attorneys and agents at the Office's home page, <http://www.uspto.gov>. Click on "Site Index" at the top of the home page. Then, in the alphabetical list, click on "Agent and Attorney Roster". Then click on "Attorney/Agent Search".
  - (B) Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

### ***MPEP***

3. All the US patent laws and rules of examination are in the *Manual of Patent Examining Procedure*, 8<sup>th</sup> edition, which is available through the Office's web site, <http://www.uspto.gov>. Click on "Site Index" at the top of the home page. Then, in the alphabetical list, click on "Manual of Patent Examining Procedure (MPEP) Information Page". The next page gives instructions for viewing individual chapters and parts of the Appendix in .pdf format and for purchasing a paper copy of the MPEP.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. the claimed invention is directed to non-statutory subject matter. The claim is directed to neither a "process" nor a "machine" (system), but rather embraces or overlaps two different statutory classes of invention. See MPEP § 2173.05(p)II and para. 10 below.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).
9. In the present instance, claim 1 (lines 1-2) recites the broad recitation "display equipment which is placed in advance in public facilities", and the claim also recites (lines 2-4) **"including inside/outside of the railway stations, air port lobbies, public squares, halls or walls/roofs of buildings"**, which is the narrower statement of the range/limitation. Also, claim 1 (line 16) recites the broad recitation "display equipment is placed in public facilities", and the claim also recites (lines 16-17) **"including the railway stations or on the walls in the streets"**, which is the narrower statement of the range/limitation.
10. In addition, the claim is in narrative form and mixes the structural elements of a system claim with the steps of a method claim. From the disclosure, the examiner interpreted the

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applicant's intended invention as a system (apparatus). A system or apparatus is defined by its structure. The structure which goes to make up the system must be clearly and positively specified. The manner of using or operating the system/apparatus cannot distinguish the claim over the prior art. See MPEP § 2114. In addition, each claim must be written as one sentence only. Note the format of the claims in the patent(s) cited.

11. This rejection may be overcome by deleting from the claim the narrower statements printed above (para. 9) in **bold**. In addition, applicant must rewrite the claim as a single sentence and delete all of the process/method steps. However, applicant may include functional limitations that help define the structure of the invention; see MPEP § 2173.05(g).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1 is rejected under 35 U.S.C. 103(a) as being obvious over by Atkinson (US20010039571A1) in view of Mankovitz (US006253069B1) and further in view of Girouard et al. (US 4982346)
14. Atkinson teaches a two-way communication system with a Web-corresponding portable terminal unit (PTU) and an image display equipment in a public space, comprising: an image display equipment placed in a public facility (para. [0111]); *personal devices* (para. [0003] and [0113]), which read on a Web-corresponding PTU, carried by people watching the program, and by which can respond immediately; a *Local Media Manager 200* (Information Manager) capable of immediately processing transmitted information input by the audience, and display response information through live telecast images or accumulated pictures (para. [0032]-[0034]); the *personal devices*/PTU being capable of opening *web pages* (Home pages, para. [0094]) for collecting information; capability to telecast *synchronized advertisements* (para. 0011), which reads on telecasting advertisements effectively; and means to determine the demographics of the public space/public facilities (para. [0119]),

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which reads on means to classify audiences into various categories from questionnaires sent.

15. Atkinson does not teach the ID of a program displayed on the image display. Mankovitz teaches the ID of a program displayed on the image display (col. 2 lines 20-24). Atkinson teaches transmitting the programs to the *personal devices*/PTU as well as to the public image display equipment. Because the Mankovitz system of program IDs would be much simpler than the dual-transmission taught by Atkinson, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Mankovitz to those of Atkinson.
16. Atkinson does not teach a lottery. Girouard et al. teaches a lottery (*promotional sweepstakes*, col. 1 lines 27-34). Because Girouard et al. teaches that the lottery promotes the advertised products, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Girouard et al. to those of Atkinson.

***Special Note for Applicant Pro se<sup>1</sup>***

17. In this Office action the examiner has judged the claims on their face (*prima facie*) to be non-patentable, because they are taught by or obvious from the cited prior art references. If applicant disagrees with the examiner's judgment, applicant should respond by filing arguments explaining, as precisely as possible, where the rejection in para. 13-16 above is wrong. In doing so applicant should recognize that the entire reference is available to support the rejection, not just the sections cited above by the examiner. Applicant should also recognize that MPEP § 2111 and 2111.01 require the examiner to give claims language its "broadest reasonable interpretation" unless applicant has provided a "clear definition" of the terms in the specification. Hence, if applicant believes the examiner's implicit interpretation is wrong, applicant should explain where a "clear definition" of the term(s) appears in the specification.
18. Applicant may also amend the claims to overcome the rejection. Applicant can do so in the current application only if the amending matter is presented in the current application. A "new matter" rejection will result if the examiner cannot find the material in the specification. Hence, it is to applicant's advantage to applicant to point out in the reply where in the

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<sup>1</sup> An applicant representing himself or herself, without benefit of a patent agent or attorney.

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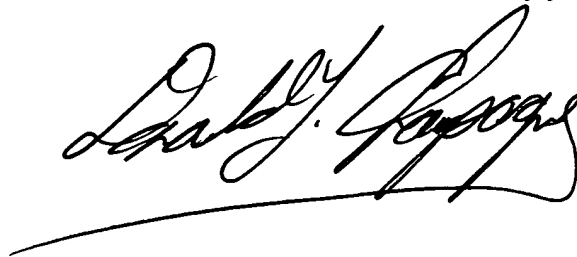
disclosure the amending material appears. Amendments must be made consistent with the requirements of 37 CFR § 1.52, which is in Appendix R of the MPEP cited above.

19. Applicant is entitled to contact the examiner to schedule a half-hour "interview" with the examiner to discuss the application, which may be done by telephone or in person, as applicant chooses.

***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
21. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

25 June 2004



Donald L. Champagne  
Examiner  
Art Unit 3622